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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,172	03/17/2006	Hitoshi Omori	ASAIN0178	3895
113 7590 11/03/2008 GRIFFIN BUTLER WHISENHUNT & SZIPL LLP SUITE PH-1 2300 NINTH STREET SOUTH ARLINGTON, VA 222042396				
EXAMINER RACHUBA, MAURINA T				
ART UNIT		PAPER NUMBER		
3727				
MAIL DATE		DELIVERY MODE		
11/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,172

Applicant(s)

OMORI ET AL.

Examiner

Maurina Rachuba

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6-11 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,12,13, and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 2, 3, 6-11, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 13 August 2007. Applicant is strongly advised not to file any divisional applications until prosecution of this pending application is concluded, as any claims dependent from generic or linking claims will be examined when the generic or linking claims are deemed allowable.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 1, the tool body being cylindrical, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. Applicant's argument has overcome the previous rejection under 35 USC 112, 2nd paragraph.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 4, 5, 12, 13 and 15-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the drawings, or specification, for the tool body being cylindrical, or for the drum having first and second grooves. It is noted that figure 4, referred to as having grooves by applicant's arguments, shows an extended portion on either side of the drum, but no grooves. It is noted that the drawings show the tool body being elongated, but not

having any particular cross-sectional shape, and the drum having bearings on either side, but not the shape of the opening the bearings are fitted to.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al, 4,958,463 in view of Nisimura, 3,953,942, as set forth in the Office action mailed 11, July 2008. Further, regarding the tool body having a length, a radius and being cylindrical in shape. It is noted that the tool body disclosed by '463 has a length, but it is not clear if the tool body has a radius, or is cylindrical, or that the tool body has a length substantially greater than the radius. However, as there is no disclosure that the shape of the tool body has any criticality or adds unexpected results

to the functioning of the device, it is the examiner's position that it would have been an obvious matter of design choice to make the different portions of the tool body of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

7. Claims 5, 13, 15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al, 4,958,463, in view of Nisimura, 3,953,942, as applied to claims 1, 4 and 12, and further in view of Ohmori, 6,056,629, as set forth in the Office action mailed 11 July 2008. Please refer to the rejection above for a discussion on the shape of the tool body. Further, '463 does not disclose the tool body having a tubular portion formed by a cavity that the tool is disposed in; the tool having first and second grooves on first and second sides, the tool having a bearing disposed in the axle hole, or the correction means disposed on a surface of the tool body defining the cavity. '629, for example figure 4, teaches a tool body having a tubular portion, the tool having first and second openings or grooves on the side (in the axle that extends through the tool), a bearing disposed on each side of the axle, in the openings or grooves, and the correction means disposed on a surface of the tool body defining the cavity. It would have been obvious to one of ordinary skill in the art to have provided '463, that discloses an open framework about the tool, with a tubular shape, as there is no disclosure that the shape of the tool body has any criticality or adds unexpected results to the functioning of the device, it is the examiner's position that it would have been an obvious matter of design choice to make the different portions of the tool body of

whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Further, it would have been obvious to have provided '463 with the bearings and grooves taught by '629, for the predictable result of allowing the tool to rotate freely, without friction between the tool and tool body, and to maintain the compact size of the tool. Further '629 clearly teaches that the correction means, the electrode **20**, is within the cavity of the tool body, for the predictable result of allowing the electrode to correct the machining surface of the tool.

Response to Arguments

6. Applicant's arguments filed 10 October 2008 have been fully considered but they are not persuasive. Applicant argues that Hess does not teach the invention of claim 1 as amended. Please refer to the rejection above. Absent a showing of unexpected results, it is the examiner's position that a change in shape would have been obvious. Applicant argues that Ohmori does not disclose the grooves as claimed. Please refer to the rejection above. It is the examiner's position that the openings in the drum, shown in figure 4, are grooves as claimed. It is noted that applicant has not claimed any function or use for the grooves, or any structure that would function with the grooves. Regarding applicant's arguments concerning Nisimura, please note that Nisimura is relied on to teach that it is old and well known to drive a tool using a gearing system, as was set forth in the Office action mailed 11 July 2008. Hess clearly teaches the other structures as claimed. Applicant appears to be arguing against the references

individually, however, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant further argues that there is no legitimate reason to combine Hess, Nisimura and Ohmori, as applicant believes that Hess discloses a polishing tool, and not a machining tool, the tools of Hess and Nisimura are bulky, they look different than the tool of Ohmori, therefore one of ordinary skill would not know how to integrate the disparate structures. In response to applicant's argument that Hess is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hess clearly teaches a machining tool, see the abstract ("An arrangement for controlledly removing material from an effective surface of a workpiece..."), and therefore is within applicant's field of endeavor. Applicant's argument that the devices of Hess and Nisimura are bulky is not well taken, applicant has not claimed any structure that would require less bulk or size. In response to applicant's argument that one of ordinary skill would not know how to incorporate the teachings of the cited references, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is the examiner's position that one of ordinary skill, reviewing the teachings of the cited references, would find applicant's claimed invention obvious under 35 USC 103.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is **571 272 4493**. The examiner can normally be reached on **Monday-Friday**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on **571 272 4475**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/
Primary Examiner, Art Unit 3727